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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,173	11/19/2003	Jeffrey L. Anderson	CM-006C (Div.)-US	9325
7590	09/08/2004		EXAMINER	
Neil E. Hamilton 8310 16th Street, M/S 509 P.O. Box 902 Sturtevant, WI 53177-0902			SELLERS, ROBERT E	
			ART UNIT	PAPER NUMBER
			1712	

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/718,173	ANDERSON ET AL.
	Examiner Robert Sellers	Art Unit 1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address.

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 22 July 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 2,3,10,12,13,21,33,34 and 41-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 2,3,10, 33, 34, 41 52 and 54 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    - a) All
    - b) Some \*
    - c) None of:
      1. Certified copies of the priority documents have been received.
      2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
      3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)              |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/23/2004</u> . | 6) <input type="checkbox"/> Other: _____.  |

1. Claims 12, 13, 21, 42-51 and 53 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected non-elected inventions, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on July 22, 2004. Claim 51 was inadvertently omitted from the listing of the claims in the restriction requirement mailed June 25, 2004 (page 2) but is hereby withdrawn due to its dependency upon claim 50 which was included in non-elected Group I.

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The following title is suggested: NON-GELLED PRODUCT OF ADDITION AND CONDENSATION POLYMERS WITH MUTUALLY REACTIVE GROUPS.

3. The specification on page 1 according to the preliminary amendment filed November 19, 2003, page 1, paragraph [0001], line 2 should be amended to update the status of parent application no. 09/930,912 by inserting after "August 16, 2001" the phrase "U.S. Patent No. 6,696,522,".

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2, 3, 10, 33, 34, 41, 52 and 54 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Independent claims 52 and 54 require the B polymer to contain functional groups that are co-reactive with those of the A polymer and includes hydroxyl groups. The reactive functional groups of the A polymer have been limited to hydroxyl groups. The functional groups of the B polymer cannot be co-reactive with the hydroxyl groups of the A polymer when they are also hydroxyl groups.

5. The term "essentially non-gelled" in claim 52, the last line is unclear since the parameters of the word "essentially" cannot be ascertained. The specification on page 1, lines 2-3 as well as independent claim 54 denotes the composition as being "**substantially** non-gelled" which implies a reaction between the A and B polymers up to the point of curing.

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 2, 3, 10 and 52 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6, 8, 9 and 11 of U.S. Patent No. 6,162,860. Although the conflicting claims are not identical, they are not patentably distinct from each other. The claims of the instant application confine the reactive functional groups of the A polymer to hydroxyl groups which is embrace by claim 4 of the patent. The additional non-aqueous solvent of the patent is not precluded by the polymeric composition of the instant application "comprising" the reaction product of the A and B polymers. According to page 15, lines 4-5 of the instant specification, "[t]he polymeric compositions of this invention may be used neat, in solvent, in water. . ."

8. Claims 2, 3, 10 and 52 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6, 9, 10 and 16 of U.S. Patent No. 6,194,510. Although the conflicting claims are not identical, they are not patentably distinct from each other for the reasons of record set forth in previous paragraph 7 except instead of the non-aqueous solvent, this patent requires water which is also within the realm of the "comprising" language of the claims of the instant application according to page 15, lines 4-5.

9. Claims 2, 3, 10 and 52 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 6,372,841. Although the conflicting claims are not identical, they are not patentably distinct from each other. The reactive functional groups of the A polymer in the patent are not recited. It would have been obvious to employ hydroxyl groups as the reactive functional groups of the A polymer which will readily react with the carboxyl, epoxy, oxazolinyl, ester and/or isocyanato co-reactive functional groups of the B polymer. The claimed polymeric composition "comprising" the reaction product embraces the non-aqueous solvent as indicated on page 15, lines 4-5 of the instant specification.

10. Claims 33, 34, 41 and 54 are directed to a 100% solids ink composition which excludes the non-aqueous solvent of U.S. Patent Nos. 6,162,860 and 6,372,841 as well as the water of U.S. Patent No. 6,194,510.

11. Independent claims 52 and 54 limiting the reactive functional groups of the A polymer to hydroxyl groups overcomes the closest prior art to Japanese Patent Nos. 59-142242 and 2-279729, Tobias Patent No. 4,341,682; Ting et al. Patent No. 4,480,058; Brown et al. Patent No. 4,585,813 and Huemke et al. Patent No. 5,389,705 which disclose ungelled reaction products of carboxy-functional addition copolymers, not the claimed A polymer which is an addition polymer having hydroxyl groups.

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12. Shay et al. Patent No. 4,217,377 and McGinniss et al. Patent No. 4,246,369 espouse ungelled powder coatings derived from functional groups-containing acrylic polymers and reactive polymers which are not prereacted to a substantially non-gelled state as claimed.

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Monday to Friday from 9:30 to 6:00 EST

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Robert Sellers  
Primary Examiner  
Art Unit 1712

rs  
9/3/04